1648

Atty Dkt No. PP1617.002
2300-1617
PATENT

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11/14/01 Susan LaMont
Date Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

COIT et al.

Serial No.: 09/721,479 Art Unit: 1648

Filing Date: November 22, 2000 Examiner: S. Brown

Title: NOVEL HCV NON-STRUCTURAL POLYPEPTIDE

AMENDMENT TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith for filing is a Response to Restriction Requirement in the above patent application in response to the Office Action of October 15, 2001.

_ Petition for Extension of Time enclosed.

X No additional fee is required.

X Also enclosed: postcard

No. of Claims After Amendment			Most Claims Previously Paid		Extra Claims				Additional Fee
A. Total Claims		-		=		x	$18	=	$
B. Ind. Claims		-		=		x	$84	=	
C. If amended to contain multiple dependent claims, add 280							$280	=	$
D. Total Amendment Fee (Total of A, B & C)								=	
E. If small entity, 50% reduction of Total Amendment Fee (50% of D)								=	

F. Total Amendment Fee (D minus E)	=	$

___ A check for $ to cover the extension of time fee and extra claims fee is attached.

___ Charge $ to Deposit Account No. 18-1648.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: Nov 14, 2001 By: DPasternak

Dahna S. Pasternak
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Susan LaMont
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

COIT et al.

Serial No.: 09/721,479 Group Art Unit: 1648

Filing Date: November 22, 2000 Examiner: S. Brown

Title: NOVEL HCV NON-STRUCTURAL POLYPEPTIDE

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the second Restriction Requirement dated October 15, 2001 (Paper No. 19) wherein the Examiner required election of one of the following groups of claims:

Group I (claims 1-19 and 32), drawn to an HCV polypeptide;

Group II (claims 20-31), drawn to an HCV polynucleotide;

Group III (claims 33-37), drawn to a method of preparing an HCV polypeptide;

Group IV (claims 38-40), drawn to an antibody that binds to an HCV polypeptide;

Group V (claim 41), drawn to a method of eliciting an immune response comprising administering a polypeptide; and

Group VI (claim 42), drawn to a method of eliciting an immune response comprising administering a polynucleotide.

Applicants hereby elect to prosecute the claims of Group I, claims 1-19 and 32, **with traverse**.

In support of the restriction requirement, the Examiner asserts that the claims of each group are patentably distinct. However, Applicants note that two criteria must be met for a proper restriction requirement under M.P.E.P. § 803: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants respectfully submit that the Examiner has not met this burden.

In particular, the Examiner has not shown that it would impart a serious burden to examine the claims of Groups I and II together or the claims of Groups III to VI together. Applicants respectfully point out that the allegedly distinct inventions of Groups III and VI share the same classification (Class 435) while Groups IV and V are both classified in Class 424. Additionally, Applicants note that the claims in all of the allegedly distinct depend ultimately from claim 1 (Group I). In view of the close interrelatedness of the claimed inventions, it would not be a serious burden on the Examiner to search and examine the inventions of Groups I and II (HCV polypeptides and polynucleotides encoding these polypeptides) together as well as Groups III and VI (methods of preparing HCV polypeptides, methods of eliciting an immune response using the claimed HCV polypeptides or polynucleotides encoding these polypeptides) together, especially in light of the fact that all pending claims depend from either claim 1 (Group I).

In sum, applicants submit that the Restriction Requirement be redefined to combine, at a minimum, Groups I to II as one group and Groups V and VI as another. As acknowledged by the Examiner's classification, the search required for each of these Groups would reveal art relevant to other Group. Therefore, examination of these allegedly distinct inventions in one application would not only not place an undue burden on the Examiner, but would actually save the Examiner time.

Applicants expressly reserve their right under 35 USC §121 to file one or more divisional applications directed to the nonelected subject matter during the pendency of this application.

Please direct all further communications regarding this application to:

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Respectfully submitted,

Date: Nov 14, 2001

By: D Pasternak
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